

Docket No. 248247US0



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Kiyoshi TOMIOKA

SERIAL NUMBER: 10/765,832

ATTN: APPLICATION BRANCH

FILING DATE: January 29, 2004

FOR: PRODUCTION METHOD OF BETA-AMINO ACID

FILING OF DECLARATION UNDER 37 CFR 1.53(f)

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Responsive to the notification dated March 24, 2004, and in accordance with the provisions of 37 CFR 1.53(f), Applicants submit herewith a Rule 63 Declaration. The required fee was paid at the time of filing the application.

The Declaration enclosed herewith contains the Title of the Invention and Inventor(s) name(s) and is believed, in combination with the application serial number and filing date contained in this cover letter, to adequately identify the above-identified application in accordance with 37 CFR 1.63, as set forth in MPEP Section 601.01.

In light of the foregoing, this application is deemed to be in proper condition for examination and such favorable action is earnestly solicited.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Vincent K. Shier, Ph.D.

Registration No. 50,552

Customer Number

22850

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(OSMMN 05/03)



Declaration, Power of Attorney and Petition

WE (I) the undersigned inventor(s), hereby declare(s) that:

My residence, post office address and citizenship are as stated below next to my name,

We (I) believe that we are (I am) the original, first and joint (sole) inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled

PRODUCTION METHOD OF β -AMINO ACID

the specification of which

- ☐ is attached hereto.
- ☒ was filed on January 29, 2004 as
Application Serial No. _____
and amended on _____
- ☐ was filed as PCT international application
Number _____
on _____,
and was amended under PCT Article 19
on _____ (if applicable).

We (I) hereby state that we (I) have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

We (I) acknowledge the duty to disclose information known to be material to the patentability of this application as defined in Section 1.56 of Title 37 Code of Federal Regulations.

We (I) hereby claim foreign priority benefits under 35 U.S.C. §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed. Prior Foreign Application(s)

Application No.	Country	Day/Month/Year	Priority Claimed
<u>114593/2003</u>	<u>Japan</u>	<u>18/4/2003</u>	<input checked="" type="checkbox"/> Yes <input type="checkbox"/> No
_____	_____	_____	<input type="checkbox"/> Yes <input type="checkbox"/> No

We (I) hereby claim the benefit under Title 35, United States Code, §119(e) of any United States provisional application(s) listed below.

(Application Number)

(Filing Date)

(Application Number)

(Filing Date)

We (I) hereby claim the benefit under 35 U.S.C. §120 of any United States application(s), or under §365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

Application Serial No.

Filing Date

Status (pending, patented,
abandoned)

And we (I) hereby appoint the following registered practitioner(s):



22850

as our (my) attorneys, with full powers of substitution and revocation, to prosecute this application and to transact all business in the Patent Office connected therewith; and we (I) hereby request that all correspondence regarding this application be sent to



22850

We (I) declare that all statements made herein of our (my) own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Kiyoshi TOMIOKA

NAME OF FIRST OR SOLE INVENTOR

Kiyoshi Tomioka

Signature of Inventor

February 16, 2004

Date

Residence: Yokohama-shi, Kanagawa, Japan

Citizen of: Japan

Mailing Address: 1-2-C-904, Nakagawa,

Tsuzuki-ku, Yokohama-shi, Kanagawa 224-0001

Japan

Docket No. 248247US0

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

RE APPLICATION OF: :

Kiyoshi TOMIOKA

: ATTN: APPLICATIONS DIVISION

SERIAL NO: 10/765,832

FILED: JANUARY 29, 2004

FOR: PRODUCTION METHOD OF BETA-AMINO ACID

DECLARATION UNDER 37 C.F.R. §1.132

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313-1450

SIR:

Now comes Kiyoshi TOMIOKA, Hirohisa DOI, Takeo SAKAI, Ken-ichi YAMADA, and Mayu IGUCHI who depose and state that:

1. The following disclosures of the present invention were made:

a) A poster presentation entitled: "External Chiral Ligand-Controlled Asymmetric Conjugate Addition of Lithium Amides to α,β -unsaturated esters" (Report No. 29[P1]I-069) at the 123rd annual meeting of the Pharmaceutical Society of Japan held from March 27, 2003 to March 29, 2003. A corresponding Abstract was published by the Pharmaceutical Society of Japan, 123rd annual meeting organizing committee on March 5, 2003 and appeared on page 98 of the meeting publication. In addition, the information pertaining to the 123rd annual meeting of the Pharmaceutical Society of Japan was internet-accessible (at <http://202.209.162.53/123/i/youshiview.asp?Ttoshi=551&KenSyu=1>) as of February 1, 2003.

The presenters of the poster (and Abstract) was listed as follows:

1. Hirohisa DOI,
2. Takeo SAKAI,
3. Ken-ichi YAMADA, and
4. Kiyoshi TOMIOKA.

b) An internet report entitled: "Chiral Ligand-Controlled Asymmetric Conjugate Addition of Lithium Amides to Enoates", which corresponds to the publication J. Am. Chem. Soc. Vol. 125, No. 10 (2003), 2886-2887, posted on February 12, 2003. This report was internet-accessible at the following URLs: (i) <http://pubs.acs.org/cgi-bin/abstract.cgi/jacsat/2003/125/i10/abs/ja029633z.html>, (ii) <http://pubs.acs.org/cgi-bin/article.cgi/jacsat/2003/125/i10/html/ja029633z.html>, (iii) <http://pubs.acs.org/cgi-bin/article.cgi/jacsat/2003/125/i10/pdf/ja029633z.pdf>, and (iv) http://pubs.acs.org/subscribe/journals/jacsat/suppinfo/ja029633z/ja029633zsi2003_0122_101638.pdf (Supporting Information).

The authors of this internet report was listed as follows:

1. Hirohisa DOI,
2. Takeo SAKAI,
3. Mayu IGUCHI,
4. Ken-ichi YAMADA, and
5. Kiyoshi TOMIOKA.

c) A published report entitled: "Chiral Ligand-Controlled Asymmetric Conjugate Addition of Lithium Amides to Enoates", J. Am. Chem. Soc. Vol. 125, No. 10 (2003), 2886-2887, published on March 12, 2003.

The authors of this publication was listed as follows:

1. Hirohisa DOI,
2. Takeo SAKAI,
3. Mayu IGUCHI,
4. Ken-ichi YAMADA, and
5. Kiyoshi TOMIOKA.

2. That Kiyoshi TOMIOKA is a named inventor of U.S. Application 10/765,832, filed on January 29, 2004.

3. That Hirohisa DOI, Takeo SAKAI, Ken-ichi YAMADA, and Mayu IGUCHI are listed as presenters/authors of the disclosures set forth in paragraph (1); however, Hirohisa DOI, Takeo SAKAI, Ken-ichi YAMADA, and Mayu IGUCHI did not make an inventive

contribution to the claimed and/or disclosed invention in U.S. Application 10/765,832, filed on January 29, 2004.

5. That the disclosures set forth in paragraph (1) are the Applicant's own work and is not the work of another. Hirohisa DOI, Takeo SAKAI, Ken-ichi YAMADA, and Mayu IGUCHI were only assistants in carrying out the experiments and did not make an inventive contribution to the claimed and/or disclosed invention in U.S. Application 10/765,832, filed on January 29, 2004.

6. The undersigned petitioner declares further that all statements made herein of their own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this application or any patent issuing thereon.

7. Further deponents saith not.

Kiyoshi Tomioka Mar. 2, 2004 Hirohisa DOI
Kiyoshi TOMIOKA Date Hirohisa DOI

Mar
Mar. 2, 2004
Date

Takeo Sakai Mar. 2, 2004 Ken-ichi Yamada
Takeo SAKAI Date Ken-ichi YAMADA

Mar. 2, 2004
Date

Mayu Iguchi Mar. 2, 2004
Mayu IGUCHI Date